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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/642,746	08/19/2003	Sofia Hermansson	018798-168	3752
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BUCHANAN INGERSOLL PC (INCLUDING BURNS, DOANE, SWECKER & MATHIS) POST OFFICE BOX 1404 ALEXANDRIA, VA 22313-1404			GIBSON, KESHIA L	
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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/642,746	Applicant(s) HERMANSSON ET AL.	
	Examiner Keshia Gibson	Art Unit 3761	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is, objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed 2/8/06 have been fully considered but they are not persuasive.

a. Applicant has argued that neither Kotmatsu nor Fischer disclose "at least one fixing tongue extending in the longitudinal direction of the incontinence pad only from the front end portion." Once the prepositional phrase is removed, this recitation is considered equivalent to "at least one fixing tongue... extending only from the front end portion." The fixing tongues of Kotmatsu extend only from one end of the pad (e.g., as opposed to one tongue extending from other a front end portion and a side portion). As such, both Kotmatsu and Fischer are considered to anticipate the claimed invention.

b. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

c. Furthermore, applicant's arguments cannot take the place of factual evidence. *In re Schulze*, 346 F.2d 600, 602, 145 USPQ 716, 718 (CCPA 1965); *In re Geisler*, 116 F.3d 1465, 43 USPQ2d 1362 (Fed. Cir. 1997).

d. In response to applicant's argument that that one would not be motivated to modify Komatsu or Fisher in view of Moretz since Moretz discloses an

absorbent piece between the fabric of an undergarment, not and incontinence pad, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

e. Newly added Claim 18 is considered present a limitation that would be obvious to one of ordinary skill in the art, as presented below.

2. Thus, despite applicant's arguments, Komatsu and Fisher are still considered to anticipate and/or render obvious the structural limitations set forth in Claims 1-18 of the claimed invention, as presented in the previous Office Action (which has been modified and presented again, in view of applicant's amendments, below).

Claim Objections

3. Claim 6 is objected to because of the following informalities: the recitation "the fastener" lacks proper antecedent for several possible reasons. It appears the antecedent basis for "the fastener" of claim 6 is intended to lie in the recitation "at least one fastener" in Claim 5. If this is the case, then the recitation lacks proper antecedent basis on at least two accounts: As required by Claim 5, the "at least one fastener" is included on the fixing tongue. Claim 6 requires the "the fastener" to be fixed to the inside of the underpants; however, the fixing tongue is not disclosed as being affixed to

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the inside of the underpants, but instead to the outside thereof. As such, the limitations of Claim 6 are not supported by the specification. Additionally, Claim 5 recites "at least one fastener" while Claim 6 recites "the fastener"; "the fastener" of Claim 6 would need be changed to "the at least one fastener" for proper antecedent basis. If the fastener of Claim 6 is not to be the same as that of Claim 5, then it is suggested the recitation "the fastener" be changed to "a fastener" for proper antecedent basis.

4. Claims 9-11 are objected to because of the following informalities: the recitation "the fastener" lacks proper antecedent basis; it is suggested this be changed to "the at least one fastener". Appropriate correction is required.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-3, 5-8, and 12-15 are rejected under 35 U.S.C. 102(b) as being anticipated by Komatsu et al. (JP 11-318985).

In regard to Claims 1-3, 5, and 7-8, Komatsu et al. disclose a disposable incontinence pad comprising an absorbent part 1 with a liquid-permeable upper layer 2, a lower backing layer 3, an absorbent body 1, and further comprising a fastening system 7/8/10 that includes a fixing tongue 7 extending only from the front end portion of the pad; the fixing tongue is an extension of the pad layers, includes a fastener 10 to be fixed to the

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outside of an pair of underpants, and can be folded around the waist of the pair of underpants (whole document).

In regard to Claim 6, the fastener may also be fixed to the inside of the pants during use (especially see Fig.1 and [0016]-[0017]).

In regard to Claim 12, the fixing tongue comprises a band of adhesive ([0016]-[0017]).

In regard to Claims 13 and 15, the pad comprises a second fixing tongue 8 comprising a second fastener 10; the fastener is arranged on the backing layer 3 (Figs., [0014]).

In regard to Claim 14, the fixing tongue 7 can be separated from the absorbent part 1 of the pad by cutting it with pair of scissors or similar device. It is further pointed out that the recitation "can be separated from the absorbent part of the incontinence pad" is considered to be functional language. It has been held that a recitation with respect to the manner in which a claimed invention is intended to be employed does not differentiate the claimed invention from a prior art satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987). *In re Paulsen*, 30 F.3d 1475, 31 USPQ 2d 1671 (Fed. Cir. 1994). Therefore, the fixing tongue of Komatsu is fully capable of being separated from the absorbent pad.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

9. Claims 1-6, 12 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fisher (US 5,290,270).

In regard to Claim 1, Fisher discloses an incontinence pad comprising an absorbent part having a lower backing layer 50, an absorbent body 54, and a fastening system having a fixing tongue 48 extending only from the front end portion of the pad (whole document). Fisher does not expressly disclose that the absorbent part has a liquid-permeable upper layer. However, it is known in the art to provide an absorbent body sandwiched between a liquid-permeable upper layer (topsheet) and a backing layer (backsheet). Thus, it would have been obvious to one of ordinary skill in the art to provide the absorbent part with an upper liquid permeable layer since it was known in the art to provide absorbent pads with a liquid permeable upper layer (topsheet).

In regard to Claims 2-6, the fixing tongue is an extension of the layers of the pad, includes at least one fastener 52 arranged to be fixed to the inside of a pair of underpants underpants; the entire fixing tongue comes to lie inside the edges of the

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absorbent when the tongue is folded over (Figs. 4-5, column 3, line 51-column 4, line 55).

In regard to Claim 12, the fixing tongue comprises a band of adhesive (Figs. 4-5, column 3, line 51-column 4, line 55).

In regard to Claim 14, the fixing tongue 48 can be separated from the absorbent part 1 of the pad by cutting it with pair of scissors or similar device. It is further pointed out that the recitation "can be separated from the absorbent part of the incontinence pad" is considered to be functional language. It has been held that a recitation with respect to the manner in which a claimed invention is intended to be employed does not differentiate the claimed invention from a prior art satisfying the claimed structural limitations. *Ex parte Maham*, 2 USPQ2d 1647 (1987). *In re Paulsen*, 30 F.3d 1475, 31 USPQ 2d 1671 (Fed. Cir. 1994).

10. Claims 9-11 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over either Komatsu et al. or Fisher.

In regard to Claim 9, Komatsu et al. and Fisher both disclose an adhesive fastener covered by a protective layer (11 and 58, respectively), but do not expressly disclose that the adhesive is a pressure sensitive adhesive. However, it is known in the art to use a pressure sensitive adhesive for attachment sanitary articles to the wearer's undergarments. Thus, it would have been obvious to one of ordinary skill in the art to select a pressure sensitive adhesive, since it has been held within the skill of a worker

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of ordinary skill in the art to select a known material on the basis of its suitability for the intended use. *In re Leshin*, 125 USPQ 416.

In regard to Claim 10, Komatsu et al. and Fisher both disclose the claimed invention but do not expressly disclose that the backing layer is treated with a release agent.

However, it is known in the art to treat the backing layers and release sheets of sanitary pads having adhesive so as to increase releasability. Thus, it would have been obvious to one of ordinary skill in the art to treat the backing layer with a release agent since it was known in the art to treat such layers with a release agent to increase releasability.

In regard to Claim 11, Komatsu et al. and Fisher both disclose the claimed invention but do not expressly disclose that the fastener is a hook and loop fastener with a protective cover connected to the backing layer. However, it would have been obvious to one of ordinary skill in the art to provide the fastener of Komatsu et al. as a hook and loop fastener since hook-and-loop fasteners and adhesive layers are art recognized equivalents for their use as attachment fasteners and the selection of any of these known equivalents to attach a sanitary pad to an absorbent article would be within the level of ordinary skill in the art.

In regard to Claim 18, Komatsu et al. and Fisher both disclose the claimed invention but do not expressly disclose that the rear end portion of the pad includes pre-stressed elastic material configuring at least a portion of the pad into a bowl shape. However, it would have been obvious to one of ordinary skill in the art to modify the pad of Komatsu et al. or Fisher to provide pre-stressed elastic material since it is known with in the art to provide an absorbent article with pre-stressed elastic material in order to shape the

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article to better fit the wearer, as supported by Widlund et al. (US 5,366,452, column 1, lines 33-46) and Runeman et al. (column 2, lines 21-29).

11. Claims 16-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over either Komatsu et al. or Fisher in view of Morteza et al. (US 5,291,617).

In regard to Claims 16-17, Komatsu et al. and Fisher both disclose the claimed invention but do not expressly disclose that the absorbent part of the pad or the pad itself has a greatest extent in the traverse direction near the fixing tongue and a smallest extent located away from the fixing tongue. Morteza et al. disclose an absorbent pad 32 for a pair of underpants having a triangular shape, with the greatest extent in the traverse direction being located nearer the waist area than a smallest extent of the pad located away from the waist area (Figures). Morteza et al. disclose that positioning the a pad having a triangular shaper in this manner permits moisture to wicked upward away from the crotch and into an air exposed to more air, implicitly leading to a drier feeling for the wearer. One would have been motivated to modify the absorbent pads of either Komatsu et al. or Fisher to have a triangular shape, as taught by Morteza et al., since doing so would allow permit an increased sense of dryness to the wearer. Thus, it would have been obvious to one of ordinary skill in the art to modify the absorbent pads of either Komatsu et al. or Fisher to have a greatest extent in the traverse direction near the fixing tongue and a smallest extent located away from the fixing tongue since doing so would allow permit an increased sense of dryness to the wearer.

Conclusion

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Keshia Gibson whose telephone number is (571) 272-7136. The examiner can normally be reached on M-F 8:30 a.m. - 6 p.m., out every other Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tatyana Zalukaeva can be reached on (571) 272-1115. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Keshia Gibson
Examiner
Art Unit 3761

klg 4/18/06

TATYANA ZALUKAEVA
SUPERVISORY PRIMARY EXAMINER

